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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/733,310	12/12/2003	Tomohiro Shinoda	LIL-0002	9083
23353 7590 09/26/2007 RADER FISHMAN & GRAUER PLLC LION BUILDING 1233 20TH STREET N.W., SUITE 501 WASHINGTON, DC 20036			EXAMINER DHILLON, MANJOT K	
			ART UNIT 3714	PAPER NUMBER
			MAIL DATE 09/26/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/733,310

Applicant(s)

SHINODA, TOMOHIRO

Examiner

Malina K. Dhillon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,5-7 and 9-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,5-7 and 9-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 February 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

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DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/19/07 has been entered.

Response to Amendment

This office action is in response to applicant's response filed on June 19th, 2007. Applicant amends claims and responds to rejections. Claims 2, 4 and 8 are canceled. Claims 9-11 have been added. Claims 1, 3, 5-7, and 9-11 are pending.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 3, 5, and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Nakamura (US 6,468,162).

Re claim 1: Nakamura discloses a gaming machine comprising data reading means for reading character data from at least one inserted trading card (col. 6, lines 35-39) under control of a CPU (20, 25, Fig. 2); and payout means for paying out at least one reward trading card (72) (see Fig. 3A; col. 13, lines 18-19) under control of the CPU (20, 23, 26, Fig. 2), wherein a set of character data of the at least one reward trading card is determined by combining the read character data, when (col. 4, lines 5-8; col. 9, lines 54-56; col. 10, lines 23-27), the prescribed conditions that are satisfied in the game (col. 3, lines 9-12; col. 11, lines 35-53; col. 16, lines 29-32).

Re claim 3: Nakamura further discloses the payout means that includes writing means for writing the updated character data in the at least one reward trading card, the updated character data being based on results of the game (col. 6, lines 12-28 and col. 11, lines 35-53).

Re claim 5: Nakamura further discloses the character data, which includes capability and attribute values (col. 6, lines 17-25).

Re claim 6: Nakamura further discloses the payout means (col. 13, lines 18-19) that includes printing means for printing an image on a surface of the at least one reward trading card (col.13, lines 11-13).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 7 and 9-11 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Muroi (US 2002/0052238).

Re claim 7: Muroi discloses a gaming machine comprising three slots into which a plurality of trading cards can be inserted, each trading card storing a set of character data (para. 0018 and para. 0022) a card reader which reads character data from at least one inserted trading card (claim 1, lines 13-17); a payout device for paying out a reward trading card (claim 8, lines 16-18; claim 4, lines 5-9). Muroi does not specifically disclose a payout, however the reward card is obtains payout via game data being written on the card. Muroi discloses a controller (11: CPU, which functions as a controller) which executes a predetermined computer program (pg. 5, right col., claim 8,

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lines 1-4), the controller (11) being connected to the card reader and the card writer (Fig. 1: the CPU is connected to the reader/writer through the data/address bus (1K) and the transmission/reception interface), wherein the controller causes the card reader to read the character data (claim 8, lines 1-7), determines the set of character data of the reward trading card by combining the read character data, (para. 0006, para. 0018 and para. 0032), and causes the payout device to pay out the reward trading card (claim 8, lines 16-18; claim 4, lines 5-9). The payout device would be the card writer that rewards the card via updated game data.

Re claim 9: Muroi discloses a method for controlling a gaming machine comprising steps of: reading character data from at least one trading card (claim 8, lines 5-7); receiving an instruction of combining the character data, when a prescribed condition is satisfied in a game (para. 0006 and para. 0032); combining the read character data to determine at least one set of updated character data (para. 0006 and para. 0032, claim 8, lines 11-14); and writing the set of updated character data to at least one reward trading card, wherein one set of character data is determined by combining two sets of read character data (claim 8, lines 16-18; claim 4, lines 5-9, para. 0006 and para. 0032). During the course of game play, the two sets of read character data is combined.

Re claim 10: Muroi discloses the method for controlling the gaming machine further comprising steps of: advancing a game based on the character data; and changing the character data based on the results of the game (claim 8, claim 4, para. 0006 and para.

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0032).

Re claim 11: Muroi discloses a gaming machine comprising: three slots into which at least two trading cards can be, each of the trading card storing a set of character data (para. 0018 and para. 0022); a card reader which reads character data from the inserted trading cards (claim 1, lines 13-17); a payout device for paying out a reward trading card (claim 8, lines 16-18; claim 4, lines 5-9). Muroi does not specifically disclose a payout, however the reward card is obtains payout via game data being written on the card. Muroi discloses a controller (11: CPU, which functions as a controller) which executes a predetermined computer program (pg. 5, right col., claim 8, lines 1-4), the controller being connected to the card reader and the payout device (Fig. 1: the CPU is connected to the reader/writer through the data/address bus (1K) and the transmission/reception interface, the payout device is the card writer), wherein the controller causes the card reader to read the character data (claim 8, lines 1-7), determines the set of character data of the reward trading card by combining the read character data (para. 0006, para. 0018 and para. 0032), and causes the payout device to pay out the reward trading card (claim 8, lines 16-18; claim 4, lines 5-9). The payout device would be the card writer that rewards the card via updated game data.

Response to Arguments

7. Applicant's arguments, page 6 of Remarks filed 6/19/07, with respect to the title and claim objections have been fully considered and are persuasive. These objections have been withdrawn due to amendments by the applicant.

8. Applicant's arguments, pages 6 and 7 of Remarks filed 6/19/07, with respect to the Nakamura and Muroi reference have been fully considered but they are not persuasive. Applicant states that in the present invention, a new character card is determined by combining a plurality of original characters, when prescribed conditions are satisfied in the game and the combining instruction is provided. In addition, the player can acquire a new character. However, these limitations are found in Nakamura and Muroi. Muroi teaches a character is created by the value defining the attribute of the character varying when prescribed conditions are satisfied in a game such as game progression (0006). Nakamura teaches the results of the game can be used to change the strength of the card, to give variety to the card, or to improve the individuality of the card (column 11, lines 50-53). The examiner interprets the phrase "prescribed conditions" to mean that the character has progressed to a certain point, or has obtained certain results in the game.

Second, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "plurality of original characters" and "acquire a new character card") are not recited in the rejected claim(s). Although the claims are interpreted in light of

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the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Malina K. Dhillon whose telephone number is (571) 270-1297. The examiner can normally be reached on Mon. - Thurs., 7 AM - 6 PM, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bob Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Malina K. Dhillon
Examiner
Art Unit 3714
MKD 9/19/07


XUAN M. THAI
SUPERVISORY PATENT EXAMINER
1C3700